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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,588	08/21/2001	Dean P. Alderucci	01-023	6856
22927	7590	01/03/2007	EXAMINER	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	01/03/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/933,588	ALDERUCCI ET AL.
	Examiner Yehdega Retta	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 28 September 2006.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-19,27-46 and 48-51 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19,27-46 and 48-51 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 1/12/04,6/2/03.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to the election filed September 28, 2006. Applicant suggested different grouping, instead of electing one of the groups indicated by the examiner. Applicant suggested Group I, which includes claims 1-19, 23, 27-46 and new claims 48-51. Applicant argues that claim 1 includes all the limitation of claim 27 therefore, should be grouped together however did not suggest why claim 23 should be included. Examiner does not believe claim 23 should be included in the group. To clarify the response to the election, Examiner provides another restriction.

Examiner is applying art rejection with the assumption that the Applicant elected Group I (with claims 1-19, 27-46 and the new claims 48-51) with traverse. Claims 20-26 and 47 are non-elected claims. If applicant does not agree with the Examiner Grouping of the claims, then the old restriction applies.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, 27-30, 31-46 and new claims 48-51 drawn to providing an offer to exchange an item and upsell for rounded price, classified in class 705, subclass 14.
- II. Claims 20, 47, drawn to receiving key presses and determining a record specifying an upsell and upsell price and selling the item and the upsell, classified in class 705, subclass 20.
- III. Claims 21 and 22, drawn to authorization to access database, classified in class 707, subclass 9.

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IV. Claim 23, drawn to offering upsell in exchange to amount tendered, classified in class 705, subclass 14.

V. Claims 24 and 25, drawn to determining upsell based on a round up amount and storing the record, classified in class 707, subclass 102.

VI. Claim 26, drawn to data structure, classified in class 717, subclass 116.

The inventions are distinct, each from the other because of the following reasons:

The reason for restriction is as indicated in the previous office action.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al.

(US 6,397,193).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1-4, Walker teaches a program for controlling a processor connected to and the processor operative with the program (see col. 7 line 57 to col. 8 line 14, col. 11 lines 48-65) to receiving a purchase that includes at least one item (see col. 7 lines 41-56); determining an upsell based on the item by accessing a database (see col. 10 lines 29-65); determining a rounded price for the at least one item and the upsell and providing an offer to exchange the at least one item and the upsell for the rounded price (col. 10 line 66 to col. 11 line 8); receiving a response to the offer and exchanging it for the rounded price (see col. 11 lines 24-32).

Regarding claims 5-16, Walker teaches to receiving a purchase that includes at least one item (see col. 7 lines 41-56); determining a record and an upsell based on the record in a database (col. 7 lines 1-17, col. 10 lines 29-65); determining a rounded price based on the record for the at least one item and the upsell and selecting an upsell that correspond to the item and the cost of the upsell and offering the upsell; determining a purchase price and a rounding multiple based on the record and rounding the purchase price in accordance with the rounding multiple; adding the purchase price to the sell price, thereby generating the rounded price; a required payment amount to be rounded price (col. 10 line 66 to col. 11 line 34);

Regarding claims 17-19 and 44-46, Walker teaches receiving signal representative of a plurality of items defining a purchase price (see col. 7 lines 41-56); determining a record in a database corresponding based on the item (see col. 10 lines 29-65); generating a rounded price based on the purchase price and the upsell; providing an offer to sell the at least one item and the upsell for the rounded price (col. 10 line 66 to col. 11 line 8); receiving a response to the offer and selling it for the rounded price (see col. 11 lines 24-32); displaying an indication of the upsell and the rounded price (col. 7 lines 8-56).

Claims 27-30 are rejected as stated above in claims 1-4.

Claims 31-43 are rejected as stated above in claims 5-16.

Regarding claims 48, 49 and 51, Walker teaches receiving key presses representative of plurality of items (see col. 4 lines 33-65); determining a record in a database specifying an upsell; receiving a key press indicating acceptance of the offer; selling the item and upsell for the rounded price (see col. 7 lines 1-56); displaying an indication of the upsell and the rounded price (col. 11 lines 23-34); storing in a record an indication of the purchase price and upsell (see 6 line 57 to col. 7 lines 17).

Regarding 50, Walker teaches receiving a request to make an adjustment to a database containing records of upsell; receiving an authorization code (see 5 lines 35-67, col. 6 line 1 to col. 7 lines 16).

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claims 17 and 18 be found allowable, claims 44 and 45 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the

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other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 44 and 45 are identical duplicate of claims 17 and 18 respectively.

Claims 1-51 are directed to the same invention as that of claims 1-25 of commonly assigned patent (US 6,397,193). The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19, 27-30, 31-46 and new claims 48-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-182 of U.S. Patent No. 6,119,099. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations from each other. Calculating a round-up amount and exchanging the round-up amount for the upsell is the same as determining a rounded price and providing an offer to exchange.

Claims 1-19, 27-30, 31-46 and new claims 48-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,598,024. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations from each other. Calculating a round-up amount and outputting a signal indicative of the upsell is the same as determining a rounded price and providing an offer to exchange.

Claims 1-19, 27-30, 31-46 and new claims 48-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 7,072,850. The current application does not recite scanning a bar code. Although the conflicting claims are not identical, they are not patentably distinct from each other because deletion of an element with a corresponding loss of function has been held to be obvious.

Claims 1-19, 27-30, 31-46 and new claims 48-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S.

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Patent No. 6,876,978. The current application does not recite printing a coupon. Although the conflicting claims are not identical, they are not patentably distinct from each other because deletion of an element with a corresponding loss of function has been held to be obvious.

Claims 1-19, 27-30, 31-46 and new claims 48-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,298,329. The current application does not recite printing a coupon. Although the conflicting claims are not identical, they are not patentably distinct from each other because deletion of an element with a corresponding loss of function has been held to be obvious.

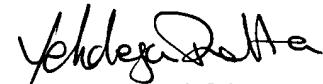
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



RETTA YEHDEGA  
PRIMARY EXAMINER

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